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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,008	07/31/2001	Kurt E. Spears	10013070-1	3181

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LUU, THANH X

ART UNIT	PAPER NUMBER
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2878

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/919,008	SPEARS ET AL.	
	Examiner	Art Unit	
	Thanh X Luu	2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,11 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,11,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to amendments and remarks filed August 26, 2004. Claims 3, 11, 17-22 are currently pending.

Election/Restrictions

1. Newly submitted claims 19-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims do not mention a lens; a tilting optical head; or a focal point.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that Applicant has failed to disclose an embodiment in which pads pivot around a pivot point and wherein the distance between the platen and the optical head is different for a first and second positions of the pads. Applicant points to Figs. 3 and 4 to support the embodiment. However, Examiner believes the claim reads on Fig. 2 of the application. In Fig. 2, the pads (208, 210) pivot around a pivot point (at 206). In the embodiments of Figs. 3 and 4, the pads do not pivot around "a pivot point." On the contrary, the pads (300 or 400) of Figs. 3 and 4 pivot around a respective pivot point (at 302 or 402 for each pad) or a plurality of different pivot points. As such, the distance between the platen and the optical head is the same (see Fig. 2 at 206) rather than different as claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (JP 11-341249, published December 10, 1999).

Regarding claim 17, Takahashi discloses (see Fig. 7) a scanner comprising: a photosensor array (5); a platen (1); and means (pads and translation means) for intentionally changing a distance of the photosensor array relative to a surface of the platen, dependent on a direction of translation of the photosensor array. That is, there

is an intentional change in a distance since Takahashi intentionally translates the photosensor array.

6. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuoka et al. (JP 63-222573, published September 16, 1988).

Regarding claim 17, Yasuoka et al. disclose (see Figs. 1 and 2) a scanner comprising: a photosensor array (4); a platen (2); and means (6 and translation means) for intentionally changing a distance of the photosensor array relative to a surface of the platen, dependent on a direction of translation of the photosensor array. That is, there is an intentional change in a distance since Yasuoka et al. intentionally moves the photosensor array.

Regarding claim 18, Yasuoka et al. disclose (see Figs. 1 and 2) a scanner, comprising: a platen (2); a photosensor array (4), the photosensor array being translated substantially parallel to the platen, where a first direction of translation (direction up to the peak of the binder in the book) causes the photosensor array to be displaced from the platen a first distance (see Fig. 2), and where a second direction (direction from the peak of the binder of the book) of translation causes the photosensor array to be displaced from the platen a different distance (see Fig. 1), where the difference in distance is predefined (by the profile the book).

7. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Ito (JP 07-327109, published December 12, 1995).

Regarding claim 11, Ito discloses (see Figs.) a method comprising: translating an optical head (2) in a direction substantially parallel to a platen (1), and; pivoting a pad

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(3), between the optical head and the platen, as a result of translating the optical head, where the distance between the optical head and the platen is a function (constant function: e.g. distance = constant + (0 * direction)) of a direction of pivoting of the pad.

Response to Arguments

8. Applicant's arguments filed August 26, 2004 have been fully considered but they are not persuasive.

Regarding claim 17, Applicant asserts that Takahashi does not disclose intentionally changing a distance. Examiner disagrees. Since Takahashi intentionally translates the photosensor array that results in a change in distance, as understood, Takahashi intentionally changes the distance as claimed.

Applicant's other assertions are moot in view of the new grounds of rejections.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878

11/2004